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BRIEF ON APPEAL TO THE BOARD

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	)	Docket Number: 878
	)	
Utecht et al.	)	Group Art Unit: 3654
	)	
Serial Number: 10/084,691	)	Examiner: Scott J. Haugland
	)	
Filed: 2/27/02	)	

For: Hydraulic Reel Adapted For Attachment To A Skid Steer


CERTIFICATE OF MAILING

The below items are enclosed with this letter for filing in the above-identified patent application:

1. Three briefs of (15) pages each.
2. Three sets of (6) pages of drawing figures
3. Check in the amount of \$170.00

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

on: 10/6/04

  
Donald J. Ersler  
Reg No. 38,753

Dated: 10/6/04

**Transmittal of Brief on Appeal**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In compliance with the Notice of Appeal filed on October 5, 2004, this appeal brief is being filed on the above stated date.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of Utecht et al.  
Serial Number: 10/084,691  
Filed: 2/27/02

) Docket Number: 878  
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) Group Art Unit: 3654  
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) Examiner: Scott J. Haugland  
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For: Hydraulic Reel Adapted For Attachment To A Skid Steer

**BRIEF ON APPEAL**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**Real Party In Interest**

U-Tech Environmental Manufacturing Supply, Inc. of Menomonee Falls, Wisconsin is the real party in interest.

**Related Appeals And Interferences**

There are no other appeals or interferences which will directly affect or be affected by this pending appeal.

**Status of Claims**

Claims 20 - 22, 24 - 29, 31 - 35 and 37 - 39 are the subject of this appeal. No other claims are pending. Claims 1 - 19, 23, 30 and 36 have been canceled without prejudice.

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### **Status of Amendments**

A first amendment filed on June 30, 2003 was entered. A second amendment filed on April 5, 2004 with an RCE was not entered, because of a Notice of Non-Compliant Amendment. A supplemental second amendment filed on July 12, 2004 was entered. This appeal is taken from a final rejection stated in a third office action dated September 28, 2004. A response to the second amendment was not filed.

### **Summary of Claimed Subject Matter**

**Claim 20:** A method of transporting a length of hose to an area only wide enough to allow passage of a skid steer 100. The length of hose is retained in a hose reel 14; the hose reel 14 is pivotally retained in a reel frame 12; and the reel frame 12 is retained in a base frame 10. The base frame is mounted to the skid steer 100. The hose reel 14 is rotated with a hydraulic motor 16. A hydraulic reel adapted for attachment to a skid steer 1 is found starting on page 4, line 2 in figures 1 - 6.

**Claim 28:** A method of transporting a length of hose to an area only wide enough to allow passage of a skid steer 100. The length of hose is retained in a hose reel 14; the hose reel is pivotally retained in a reel frame 12; and the reel frame 12 is retained in a base frame 10. The skid steer 100 includes a quick release mount member 102. The base frame 10 is mounted to the quick release mount member 102. The hose reel 14 is rotated with a hydraulic motor 16. A hydraulic reel adapted for attachment to a skid steer 1 is found starting on page 4, line 2 in figures 1 - 6.

**Claim 35:** A method of transporting a length of hose to an area only wide enough to allow passage of a skid steer 100. The length of hose is retained in a hose reel 14; the hose reel is pivotally retained in a reel frame 12; and the reel frame 12 is retained in a base frame 10. The skid steer 100 includes a quick release mount member 102. The base frame 10 is mounted to the quick release mount member 102. The base frame 10 including a base mounting frame 20 and a pair of retention plates 32. The hose reel 14 is rotated with a hydraulic motor 16. A hydraulic reel adapted for attachment to a skid steer 1 is found starting on page 4, line 2 in figures 1 - 6.

#### **Issues**

Issue 1 -- Whether claims 20 - 22, 24 - 29, 31 - 35 and 37 - 39 are patentable under 35 U.S.C. 103(a) over Cochran et al. 4,545,720 in view of Egerstrom 4066,093.

#### **Grouping of Claims**

For each ground of rejection which appellant contests herein which applies to more than one claim, such additional claims, to the extent separately identified and argued below, do not stand or fall together.

**GROUP I:** Claims 20 - 22 and 24 - 27 stand and fall together. Issue 1 includes Group I.

**GROUP II:** Claims 28 - 29 and 31 - 34 stand and fall together. Issue 1 includes Group II.

**GROUP III:** Claims 35 and 37 - 39 stand and fall together. Issue I includes Group III.

## The Argument

Prior to discussing each art rejection appearing below as Issue 1, appellant would first like to bring to the Board's attention the following specific cases concerning hindsight reconstruction, references that teach away, and secondary considerations:

1. In re Oetiker, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992)

The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.

2. In re McLaughlin 170 USPQ 209, 443 F.2d 1392, 1395 (1971)

Any judgment on obviousness is in a sense necessarily a reconstruction base upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level or ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such reconstruction is proper.

3. Akzo N.V. v. United States International Trade Commission, 1 USPQ 2d 1241, 1246 (Fed. Cir. 1986)

[P]rior art references before the tribunal must be read as a whole and consideration must be given where the references diverge and teach away from the claimed invention. . . . Moreover, appellants cannot pick and choose among individual parts of assorted prior art references "as a mosaic to recreate a facsimile of the claimed invention."

4. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

In determining obviousness, a court must (1) determine the scope and content of the prior art; (2) ascertain the differences between the prior art and the claimed invention; and (3) resolve the level of ordinary skill in the pertinent art. Secondary considerations such as commercial success, long felt but unsolved need, and failure of others are also considered.

*Issue 1 -- Whether claims*

20 - 22, 24 - 29, 31 - 35 and 37 - 39 are patentable under 35 U.S.C. 103(a) over *Cochran et al.* 4,545,720 in view of *Egerstrom* 4066,093.

Applicant respectfully disagrees with examiner's 103(a) rejection of claims 20 - 22, 24 - 29, 31 - 35 and 37 - 39. For examiner to state that it would be obvious for one skilled in the art to produce applicant's compact tailgate lifter, he must make a prima facie case of obviousness, according to MPEP 2143.

MPEP 2143 states there are three requirements to establish a case of obviousness:

- 1) There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings.
- 2) There must be a reasonable expectation of success.
- 3) The prior art reference must teach or suggest all claim limitations.

The *Cochran et al.* patent discloses a quick coupler assembly for a skid steer. The *Egerstrom* patent discloses a hose feeding winch that is permanently mounted to a truck bed. The *Egerstrom* patent does not teach or suggest the removability of the hose feeding winch from the truck, so that the truck can be used for

other purposes, besides charging drill holes. Applicants' invention is a hydraulic reel that may be efficiently attached to and removed from a skid steer, so that the skid steer may be used for other purposes, if so desired. Examiner has not provided a motivation in either the Cochran et al. or the Egerstrom references for combining a hose feeding winch that is permanently mounted to the bed of a truck with a skid steer that has a quick coupler assembly. The quick coupler assembly is provided for quick attaching and detaching accessories. Examiner has combined two unrelated references by gleaning knowledge obtained only from applicant's disclosure, contrary to In re McLaughlin.

There would be no reasonable expectation of success, because Egerstrom teaches the permanent mounting of a complicated hose feeding winch to a bed of a large truck, not the quick attachment and detachment of the hose feeding winch to a truck bed or a skid steer. Further, the hose feeding winch has a base that is configured to be attached to a flat surface, namely a bed of a truck. The hose feeding winch base is not designed to be attached to a skid steer on an end thereof.

The prior art references do not teach or suggest all claim limitations. Egerstrom does not provide a base that may be attached to a skid steer.

Applicants further argue that Egerstrom teaches access to a drill hole by keeping a large truck in a stationary position and manipulating a telescoping operated extension unit 72 to move an end of a charging hose 44 for insertion into a drill hole.

Egerstrom does not teach or suggest making the hose feeding winch removable, nor does it teach attaching the hose feeding winch to another motor vehicle, such as the Cochran et al. skid steer. Applicants' invention provides a skid steer that is moved as close as possible to the location, where an end of the hose is to be inserted. In fact, the combination of Egerstrom and Cochran et al. teaches away from applicants' invention, Akzo N.V. v. United States International Trade Commission. Applicants' invention is moved up to the hole for insertion of the hose. Applicants' reel does not include a telescoping operated extension unit, but relies on the movement of the skid steer.

Additionally, Egerstrom has a width, which is wider than a skid steer; the truck must be backed into an area, unlike a skid steer; and a truck is not capable of traveling over extremely rough terrain as a skid steer. Further, a truck is used for hauling items and a skid steer is used for digging in the ground. Therefore, it would not have been obvious for one skilled in the art to substitute a skid steer for a truck. Examiner is engaging in hindsight reconstruction by combining the Egerstrom '093 patent and the Cochran et al. '720 patent. The Egerstrom patent discloses a hose reel mounted to a back of a truck. The Cochran et al. patent discloses a skid steer having a quick coupler for efficient attachment of a bucket. The two patents are in two completely different classification areas and do not even have cross referenced fields of search. Skid steers are primarily used for digging in the ground and trucks are not. Hindsight reconstruction



is not allowed by In re Oetiker and In re McLaughlin, when knowledge is gleaned only from applicant's disclosure, as here.

Finally, even if Egerstrom and Cochhran et al. could be combined without knowledge gleaned from applicants disclosure'; examiner must still consider secondary considerations, which overcome an obviousness rejection according to Graham v. John Deere Co. Egerstrom discloses a complicated hose feeding winch. Applicants' invention discloses a hose reel without the telescoping operated extension unit 72. Applicants' invention has a lower manufacturing cost then combining the Cochran et al. skid steer and the Egerstrom hose feeding winch. Cost and ease of manufacturing is a secondary consideration.

#### **Conclusion**

For the extensive reasons advanced above, Appellant respectfully but forcefully contends that each claim is patentable. Therefore, reversal of all rejections is courteously solicited.

Respectfully submitted,



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## Appendix

Claims 1 - 19 (canceled)

20. (twice amended) A method of transporting a length of hose to an area only wide enough to allow passage of a skid steer, comprising the steps of:

- providing a skid steer having a mounting member;
- attaching a base frame to said mounting member;
- attaching a reel frame to said base frame;
- retaining pivotally a hose reel in said reel frame, winding a length of hose on said hydraulic reel; and
- rotating said hose reel with a hydraulic motor, supplying said hydraulic motor with hydraulic oil from said skid steer.

21. (previously presented) The method of transporting a length of hose to an area only wide enough to allow passage of a skid steer of claim 20, further comprising the step of:

- attaching pivotally said hose reel to said base frame.

22. (previously presented) The method of transporting a length of hose to an area only wide enough to allow passage of a skid steer of claim 20, further comprising the step of:

- providing a quick release mounting member on said skid steer for said mounting member, a base mounting frame extending from said base frame, a pair of retention plates extending from a top of said base mounting frame, a pair of slot retention plates extending from a bottom of said base mounting frame, a pair of locking pins

extending from said quick release mounting member that are disposed to be received by said pair of slot retention plates.

Claim 23 (canceled)

24. (previously presented) The method of transporting a length of hose to an area only wide enough to allow passage of a skid steer of claim 20, further comprising the step of:

providing a hydraulic valve for controlling the flow of hydraulic oil to said hydraulic motor.

25. (previously presented) The method of transporting a length of hose to an area only wide enough to allow passage of a skid steer of claim 20, further comprising the step of:

extending an axle from each end of said hose reel, said axle having an inner diameter, a hose outlet extending from said axle, said hose outlet communicating with said inner diameter, an opening being formed in said hose reel such that the length of hose may be inserted through said opening and attached to said hose outlet, one end of said axle being sealed.

26. (previously presented) The method of transporting a length of hose to an area only wide enough to allow passage of a skid steer of claim 25, further comprising the step of:

attaching a rotary union to a nonsealed end of said axle.

27. (previously presented) The method of transporting a length of hose to an area only wide enough to allow passage of a skid steer of claim 25, further comprising the step of:

attaching a pair of roller bearings to said reel frame, said axle being pivotally constrained by said pair of roller bearings.

28. (twice amended) A method of transporting a length of hose to an area only wide enough to allow passage of a skid steer, comprising the steps of:

providing a skid steer having a quick release mounting member;

attaching a base frame to said quick release mounting member;

attaching pivotally a reel frame to said base frame;

retaining pivotally a hose reel in said reel frame, winding a length of hose on said hydraulic reel; and

rotating said hose reel with a hydraulic motor, supplying said hydraulic motor with hydraulic oil from said skid steer.

29. (previously presented) The method of transporting a length of hose to an area only wide enough to allow passage of a skid steer of claim 28, further comprising the step of:

extending a base mounting frame from said base frame, a pair of retention plates extending from a top of said base mounting frame, a pair of slot retention plates extending from a bottom of said base mounting frame, a pair of locking pins extending from said quick release mounting member that are disposed to be received by said pair of slot retention plates.

Claim 30 (canceled)

31. (previously presented) The method of transporting a length of hose to an area only wide enough to allow passage of a skid steer of claim 28, further comprising the step of:

providing a hydraulic valve for controlling the flow of hydraulic oil to said hydraulic motor.

32. (previously presented) The method of transporting a length of hose to an area only wide enough to allow passage of a skid steer of claim 28, further comprising the step of:

extending an axle from each end of said hose reel, said axle having an inner diameter, a hose outlet extending from said axle, said hose outlet communicating with said inner diameter, an opening being formed in said hose reel such that the length of hose may be inserted through said opening and attached to said hose outlet, one end of said axle being sealed.

33. (previously presented) The method of transporting a length of hose to an area only wide enough to allow passage of a skid steer of claim 32, further comprising the step of:

attaching a rotary union to a nonsealed end of said axle.

34. (previously presented) The method of transporting a length of hose to an area only wide enough to allow passage of a skid steer of claim 32, further comprising the step of:

attaching a pair of roller bearings to said reel frame, said axle being pivotally constrained by said pair of roller bearings.

35. (twice amended) A method of transporting a length of hose to an area only wide enough to allow passage of a skid steer, comprising the steps of:

providing a skid steer having a quick release mounting member;  
attaching a base frame to said quick release mounting member;  
extending a base mounting frame from said base frame, a pair of retention plates extending from a top of said base mounting frame, a pair of slot retention plates extending from a bottom of said base mounting frame, a pair of locking pins extending from said quick release mounting member that are disposed to be received by said pair of slot retention plates.

attaching a reel frame to said base frame;

attaching said base mounting frame to said quick release mounting member;

attaching pivotally a reel frame to said base frame;

retaining pivotally a hose reel in said reel frame, winding a length of hose on said hydraulic reel; and

rotating said hose reel with a hydraulic motor, supplying said hydraulic motor with hydraulic oil from said skid steer.

Claim 36 (canceled)

37. (previously presented) The method of transporting a length of hose to an area only wide enough to allow passage of a skid steer of claim 35, further comprising the step of:

providing a hydraulic valve for controlling the flow of hydraulic oil to said hydraulic motor.

38. (previously presented) The method of transporting a length of hose to an area only wide enough to allow passage of a skid steer of claim 35, further comprising the step of:

extending an axle from each end of said hose reel, said axle having an inner diameter, a hose outlet extending from said axle, said hose outlet communicating with said inner diameter, an opening being formed in said hose reel such that the length of hose may be inserted through said opening and attached to said hose outlet, one end of said axle being sealed.

39. (previously presented) The method of transporting a length of hose to an area only wide enough to allow passage of a skid steer of claim 38, further comprising the step of:

attaching a rotary union to a nonsealed end of said axle.

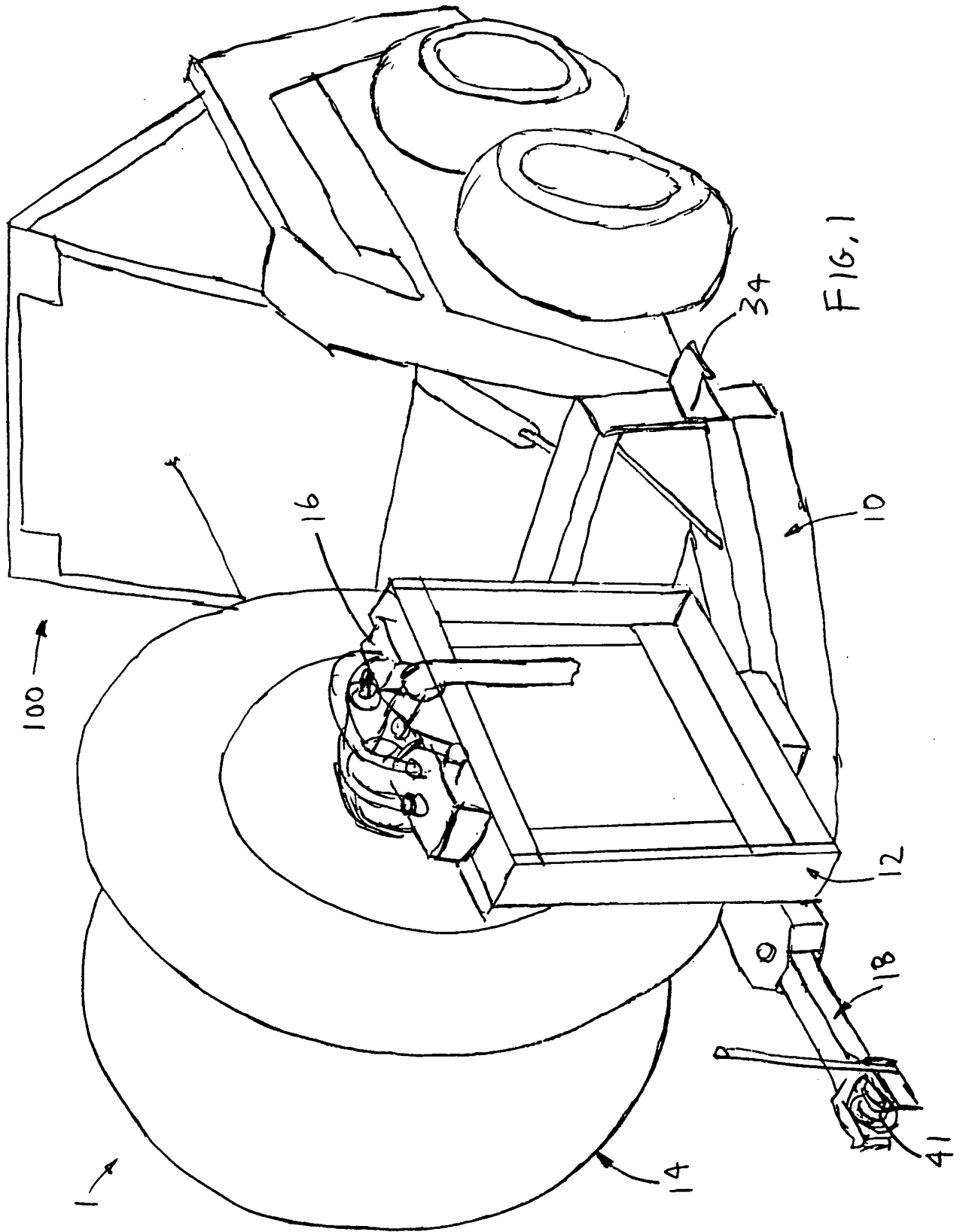
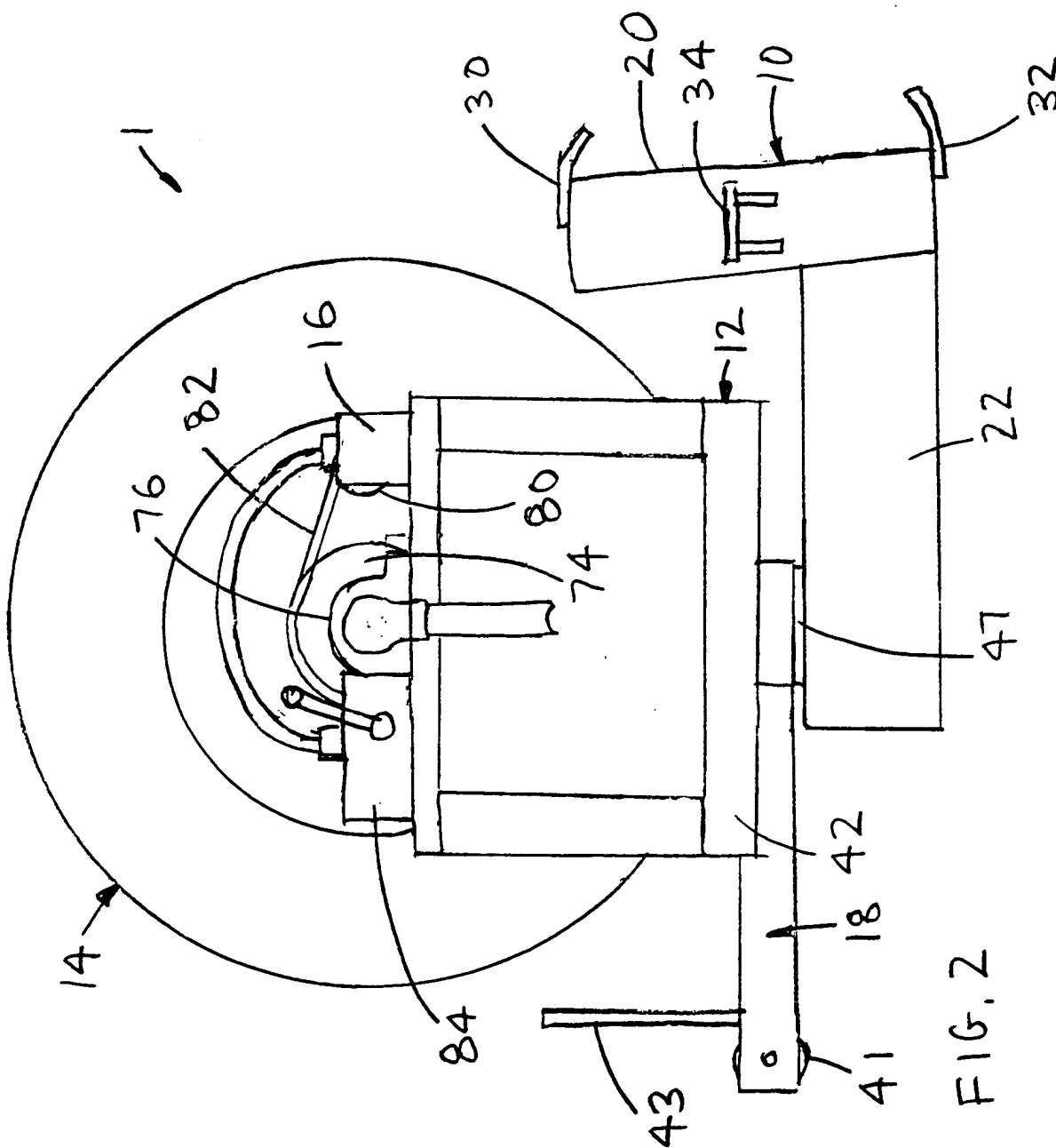


FIG. 1





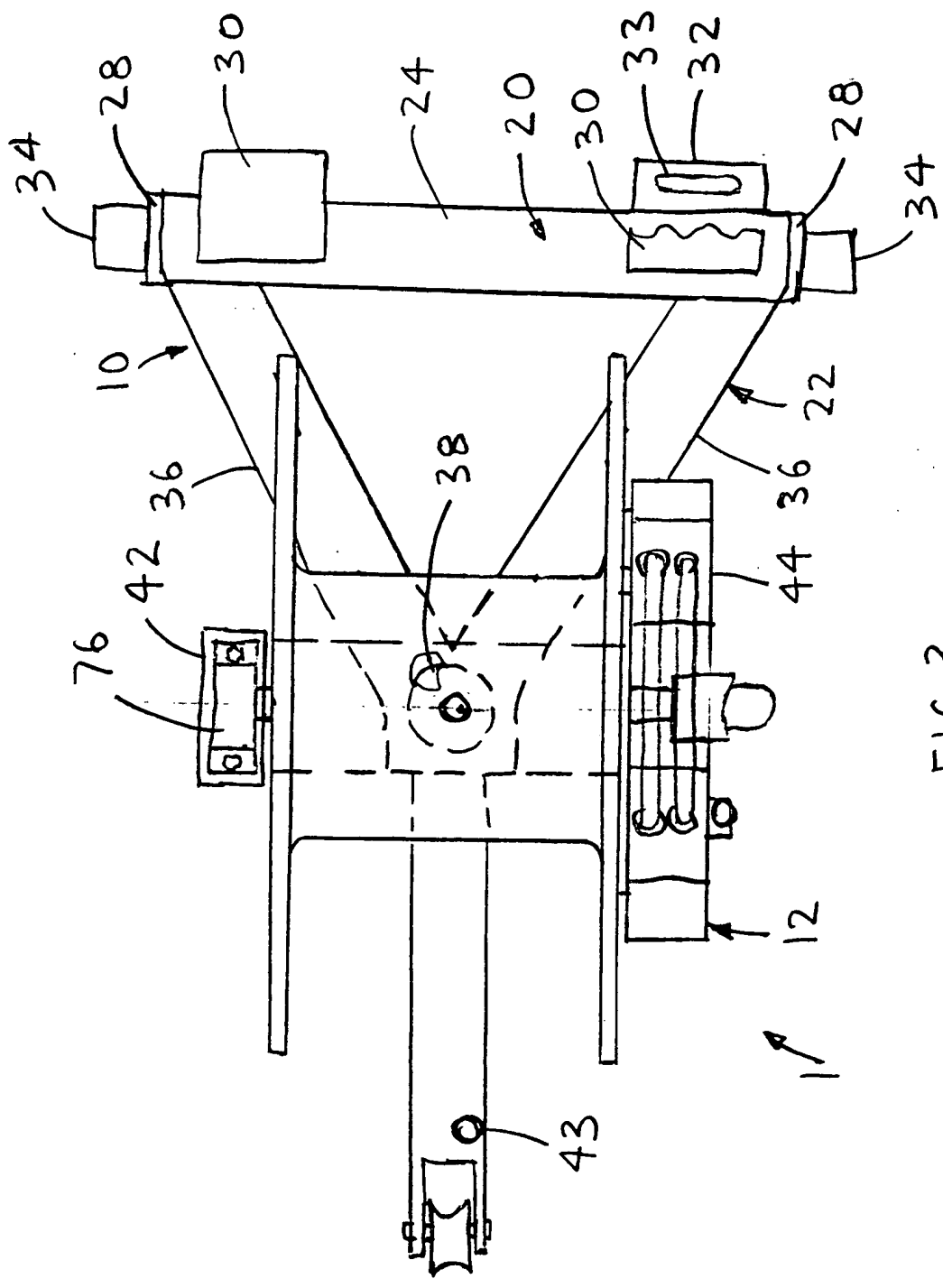


FIG. 3

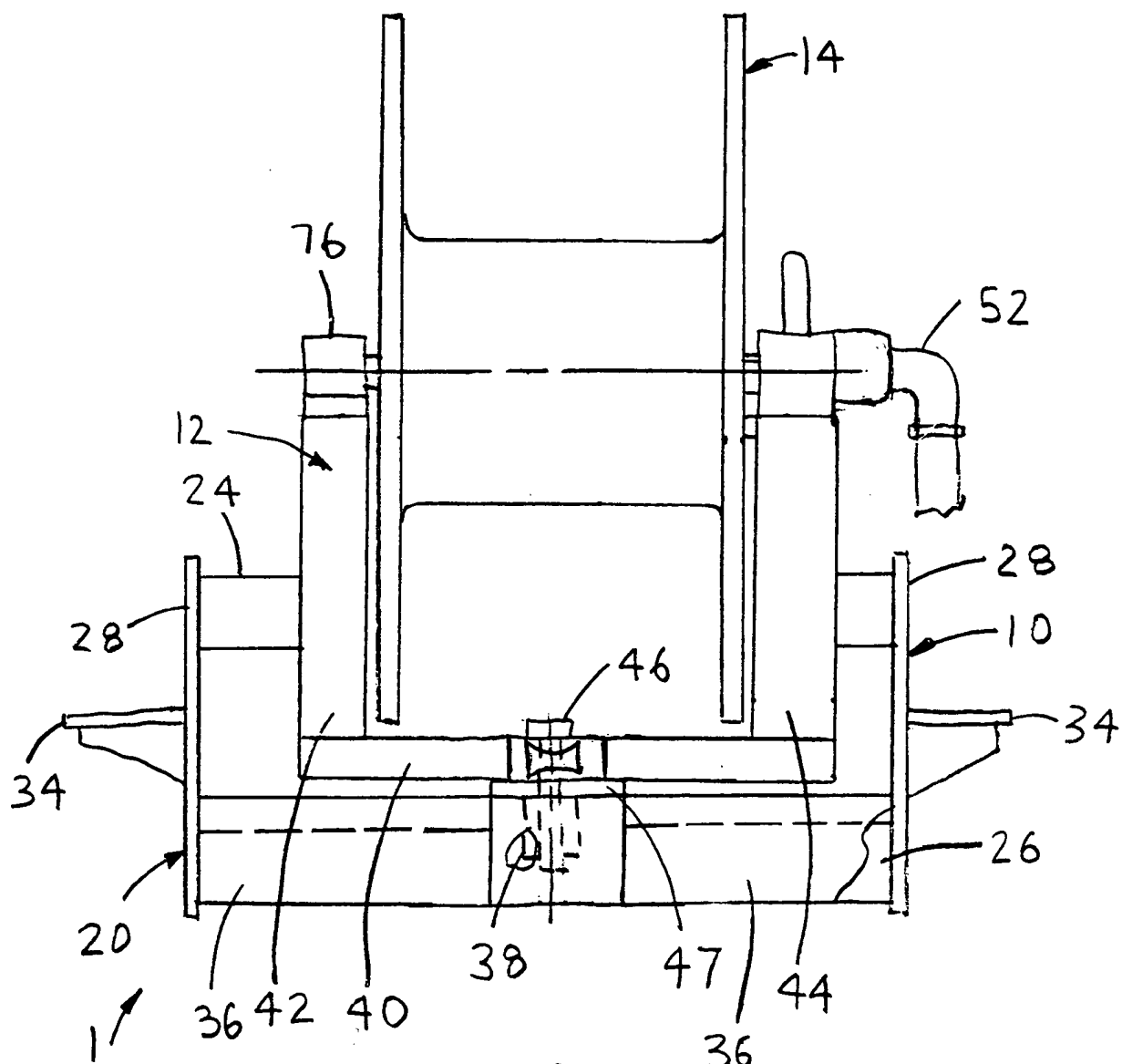
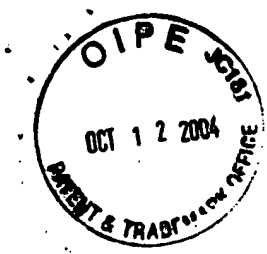


FIG. 4

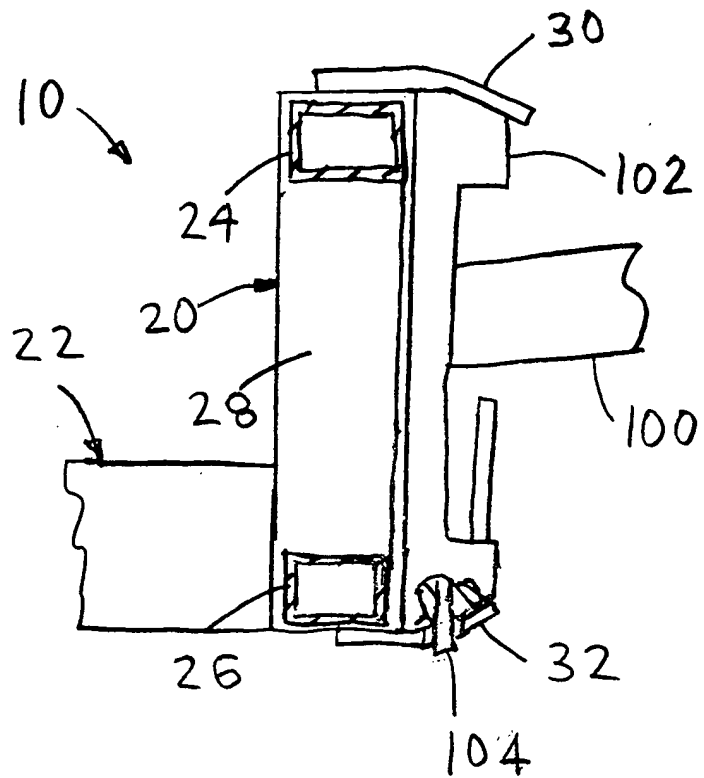


FIG. 5

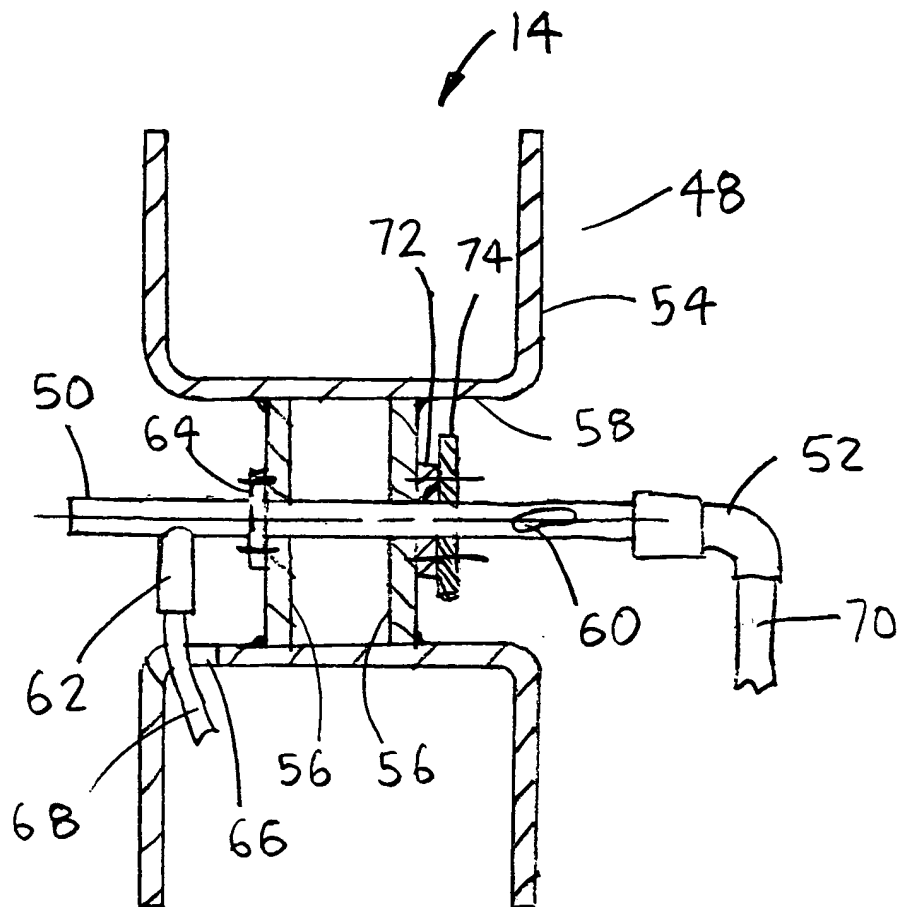


FIG. 6